

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Nancy C. Frye
Serial No.: 10/790,923
Filing Date: March 1, 2004
Confirmation No.: 1435
Group Art Unit: 3728
Examiner: Marie D. Patterson
Title: SHOE AND LAST

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

APPEAL BRIEF

Applicant has appealed to the Board of Patent Appeals and Interferences from the final decision of the Examiner issued December 26, 2007 finally rejecting Claims 1, 5, 8, 11, 14-16, 19, and 20. In response to the Notice of Panel Decision from Pre-Appeal Brief Review issued June 5, 2008, Applicant respectfully submits herewith their brief on appeal.

REAL PARTY IN INTEREST

The present application is owned by inventor/applicant Nancy C. Frye.

RELATED APPEALS AND INTERFERENCES

There are no known appeals or interferences that will directly affect or be directly affected by or have a bearing on the Board's decision in this pending appeal.

STATUS OF CLAIMS

Claims 1, 5, 8, 11, 14-16, 19, and 20 stand rejected pursuant to a Final Action issued December 26, 2007. Claims 6, 7, and 9 have been withdrawn. Claims 2-4, 10, 12, 13, 17, and 18 have been canceled. Claims 1, 5, 8, 11, 14-16, 19, and 20 are presented for appeal.

STATUS OF AMENDMENTS

A Response to Examiner's Election/Restriction Requirement was filed on September 3, 2004 in response to an Election/Restriction Requirement issued August 3, 2004. Claims 3, 8, and 9 were amended and Claim 15 was withdrawn. A Response to Examiner's Action was filed on January 7, 2005 in response to an Official Action issued October 7, 2004. Claims 1-3, 8, 10, and 11-16 were amended and Claims 6 and 7 were withdrawn. A Response to Examiner's Final Action was filed on May 3, 2005 in response to a Final Action issued March 3, 2005. Claims 1-3, 10-13, 16, 17, and 20 were amended and Claim 9 was withdrawn. A Request for Continued Examination was filed on June 2, 2005 in response to an Advisory Action issued May 16, 2005. Claims 1-3, 10-13, 16, 17, and 20 were amended and Claim 9 was withdrawn. A Response to Examiner's Action was filed on September 28, 2005 in response to an Official Action issued June 28, 2005. Claims 1, 11, and 16 were amended. A Response to Examiner's Final Action was filed on January 30, 2006 in response to a Final Action issued October 28, 2005. Claims 1, 11, and 16 were amended. A Request for Continued Examination was filed on March 28, 2006 in response to an Advisory Action issued February 27, 2005. Claims 1, 2, 10, 11, and 16 were amended. A Response to Examiner's Action was filed on July 17, 2006 in response to an Official Action issued April 17, 2006. Claims 1, 2, 8, 10, 11, 16, and 19 were amended and Claims 3, 12, and 17 were canceled. A Response to Examiner's Final Action was filed on October 6, 2006 in response to a Final Action issued August 7, 2006. Claims 1, 11, and 16 were amended and Claims 2, 4, 10, 13, and 18 were canceled. A Request for Continued Examination was filed on November 7, 2006 in response to an Advisory Action issued October 17, 2006. Claims 1, 11, and 16 were

amended and Claims 2, 4, 10, 13, and 18 were canceled. A Response to Examiner's Action was filed on February 27, 2007 in response to an Official Action issued November 28, 2006. No further amendments were made to the claims. A Response to Examiner's Final Action was filed on June 18, 2007 in response to a Final Action issued April 18, 2007. Claims 1, 5-8, 11, 16, and 19 were amended. A Request for Continued Examination was filed on July 18, 2007 in response to an Advisory Action issued July 9, 2007. Claims 1, 5-8, 11, 16, and 19 were amended. A Response to Examiner's Action was filed on November 5, 2007 in response to an Official Action issued August 3, 2007. No further amendments were made to the claims. A Notice of Appeal and Request for Pre-Appeal Brief Review were filed on March 26, 2008 in response to a Final Action issued December 26, 2007. A Notice of Panel Decision from Pre-Appeal Brief Review was issued on June 5, 2008 indicating that an appeal is to proceed to the Board of Patent Appeals and Interferences.

SUMMARY OF CLAIMED SUBJECT MATTER

With respect to Independent Claim 1, there is provided a shoe 810 including an upper 814 and an insole 816 enclosed by the upper 814. The insole 816 is a single piece layer of the shoe 810 and has a forward toe section and a rear heel section. An outsole 812 supports the insole 816 and has a planar support surface 818 directly supporting the forward toe section and the rear heel section of the insole 816 and a planar walking surface. The rear heel section of the insole 816 has a surface closer to the planar walking surface of the outsole 812 than a surface of the forward toe section of the insole 816 to place a wearer's foot in a position where the wearer's heel is closer to a walking surface than the wearer's toes during normal wearing conditions. The forward toe section of the insole 816 has a substantially constant thickness 820 from a forward periphery edge 822 of the shoe 810 to the rear heel section, the rear heel section of the insole 816 having a decreasing thickness 826 from the forward toe section of the insole 816 to a rear periphery edge 828 of the shoe 810. The rear heel section of the insole 816 and the forward toe section of the insole 816 meet at a point substantially halfway with respect to the upper surface. (See FIGURE 14 and page 29, lines 6-28).

With respect to Independent Claim 11, there is provided a shoe 810 comprising an upper 814 and an insole 816 under the upper. The insole 816 is a single piece layer of the shoe 810 and has a forward toe section and a rear heel section. The insole 816 is configured with a constantly thick forward toe section 820 and a decreasingly thick rear heel section 826. A outsole 812 lies under the insole 816 and has a planar support surface directly supporting the forward toe section of the insole 816 and the rear heel section of the insole 816 and a

planar walking surface. The rear heel section of the insole 816 has a surface closer to the planar walking surface of the outsole 812 than a surface of the forward toe section of the insole 816 to place a wearer's foot in a dorsiflexion position, wherein the constantly thick forward toe section 820 of the insole 816 and the decreasingly thick rear heel section 826 of the insole 816 meet at a point substantially halfway with respect to the outsole 812. (See FIGURE 14 and page 29, lines 6-28).

With respect to Independent Claim 16, there is provided a shoe 810 comprising an upper 814 and an insole 816 enclosed by the upper 814. The insole 816 is a single piece layer of the shoe 810 and has a forward toe section and a rear heel section. A midsole 829 separates an outsole 812 from the forward toe section of the insole 816 and the rear heel section of the insole 816. An outsole 812 supports the midsole 829 and the insole 810 and has a planar support surface supporting the midsole 829 and the insole 816 and has a planar walking surface. The rear heel section of the insole 816 has a surface closer to the planar walking surface of the outsole 812 than a surface of the forward toe section of the insole 816 to place a wearer's foot in a position where the wearer's heel is closer to a walking surface than the wearer's toes during normal wearing conditions. The forward toe section of the insole 816 has a substantially constant thickness 820 from a forward periphery edge 822 of the shoe 810 to the rear heel section of the insole 816. The rear heel section of the insole 816 has a decreasing thickness 826 from the forward toe section of the insole 816 to a rear periphery edge 828 of the shoe 810. The rear heel section of the insole 816 and the forward toe section of the insole 816 meet at a point substantially halfway with respect to the outsole 812.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1. Did the Examiner err in concluding that new drawings specifically requested by the Examiner contained new matter?

2. Did the Examiner err in concluding that Claims 1, 5, and 11 were anticipated under 35 U.S.C. §102(b) by U.S. Patent No. 5,491,912 issued to Snabb?

3. Did the Examiner err in concluding that Claims 8, 14, 16, 19, and 20 were obvious under 35 U.S.C. §103(a) over U.S. Patent No. 5,491,912 issued to Snabb?

4. Did the Examiner err in concluding that Claim 15 was obvious under 35 U.S.C. §103(a) over U.S. Patent No. 5,491,912 issued to Snabb in view of U.S. Patent No. 3,990,159 issued to Borgeas?

ARGUMENT

1. The drawings stand objected to under 37 C.F.R. §1.83(a) as not showing every feature of the invention specified in the claims. The Examiner has indicated that the drawing changes submitted adding a midsole 829 and moving the location 824 where the first portion 820 and the second portion 826 meet constitute new matter. Applicant respectfully traverses this objection.

With respect to the addition of midsole 829, Applicant submitted a replacement drawing sheet including a midsole 829 as specifically requested by the Examiner. The Examiner objected to the replacement drawing sheet as containing new matter. Applicant has shown that the specification clearly discloses that the shoe can have one or more midsoles. See page 29, lines 11-13, of Applicant's specification, where insole 816 may be in direct contact with surface 818 of outsole 812 or may be separated therefrom by one or more midsoles. The replacement drawing sheet requested by the Examiner does no more than show a midsole 829 separating an insole 816 from an outsole 812 as expressly disclosed in Applicant's specification. Moreover, the Examiner has taken Official Notice in rejecting the claims under 35 U.S.C. §103(a) that the use of midsoles between an insole and an outsole is well known and conventional but still continues to assert that new matter is being added to the drawings with the insertion of a midsole despite this Official Notice and despite the express disclosure in Applicant's specification. The replacement drawing sheet (FIGURE 14) did not add any special characteristics to midsole 829 when amended to include a midsole as requested by the Examiner. The addition of midsole 829 is consistent with the language of Applicant's specification. Therefore, Applicant respectfully submits that

the addition of midsole 829 did not add new matter to the Application.

With respect to the location of midpoint 824, Applicant has also shown that Applicant's specification clearly shows that the first portion 820 and the second portion 826 meet at a point 824 substantially halfway with respect to the upper or outsole of the shoe. (See page 29, lines 16-20, of Applicant's specification). Point 824 in the replacement drawing sheet is exactly at the halfway point of the shoe. The changes made to the drawings, as specifically required by the Examiner, literally track the exact language of Applicant's specification without deviation therefrom. Therefore, no new matter has been added in accurately reflecting point 824 pursuant to Applicant's specification.

For the convenience of the Board, attached herewith is a copy of the drawing changes made to accurately show the midsole 829 and the midpoint 824 of the insole. The drawing changes were made to provide consistency with Applicant's specification and do not add any new matter to the Application. Thus, there is no basis for the Examiner's position of new matter. Therefore, Applicant respectfully submits that the amended drawings are in accordance with 37 C.F.R. §1.83(a).

2. Claims 1, 5, and 11 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,491,912 issued to Snabb. Independent Claims 1 and 11 recite in general an insole being configured with a constantly thick forward toe section and a decreasingly thick rear heel section with the constantly thick forward section meeting the decreasingly thick rear heel section at a point substantially halfway point with respect to the upper or outsole of the shoe. By contrast, the Snabb, et al. patent clearly states that its forward toe section does not have a constant thickness until location 29. Location 29 is not at a halfway point with respect to the shoe upper or outsole as required by the claimed invention. In fact, location 29 is underneath the toes of the wearer's foot. The toes of a wearer's foot would never be considered to be at a halfway point of an upper or outsole of a shoe. Moreover, the Snabb, et al. patent clearly teaches away from having this feature at a halfway point of the shoe. (See col. 3, lines 48-50, of the Snabb, et al. patent). In addition, the negative slope of the shoe of the Snabb, et al. patent is clearly caused by the outer sole 20 and not the inner sole 24 as shown in FIGURE 2. The Snabb, et al. patent specifically states that its inner sole 24 is substantially flat both laterally and longitudinally. (See FIGURE 5 and col. 3, lines 50-53, of the Snabb, et al. patent). As a result, the inner sole 24 of the Snabb, et al. patent is not capable of providing the structure required by the claimed invention. Thus, the Snabb, et al. patent fails to teach each and every limitation of the claimed invention as required to support an anticipation rejection.

The Examiner argues that the Snabb, et al. patent has an insole with a constant thickness to point 28 under the ball of a wearer's foot. This position is not supported by the disclosure or drawings of the Snabb, et al. patent. First, the various thicknesses of the shoe of the Snabb, et al. patent is based on its outer sole 20 as its inner sole 24 is explicitly described as being both laterally and longitudinally flat. Thus, the express lateral and longitudinal flatness of the inner sole 24 of the Snabb, et al. patent means it cannot have a rear heel section with a decreasing slope as required by the claimed invention. The claimed invention describes an insole that has a longitudinal change in structure at a halfway point of the shoe. Second, the Snabb, et al. patent clearly states that the slope is decreased to 0 degrees under the toes at point 29, forward and beyond the ball centers of pressure at point 28. (See col. 4, lines 37-40, of the Snabb, et al. patent). As a result, there is no constant thickness at point 28 of the Snabb, et al. patent let alone at a point substantially halfway with respect to an upper or outsole of a shoe as required by the claimed invention. For arguments sake, even if it is assumed that the slope is 0 degrees at point 28, this would still never be considered to be at a halfway point of an upper or outsole of a shoe. Moreover, this change in slope described in the Snabb patent is caused by the outsole 20 of the Snabb, et al. shoe and not by any insole as required by the claimed invention. Therefore, Applicant respectfully submits that Claims 1, 5, and 11 are not anticipated by the Snabb, et al. patent.

3. Claims 8, 14, 16, 19, and 20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Snabb, et al. Independent Claim 1, from which Claim 8 depends, and Independent Claim 11, from which Claim 14 depends has been shown above to be patentably distinct from the Snabb, et al. patent. Independent Claim 16 includes the similar features shown above to be patentably distinct from the Snabb, et al. patent. With respect to Claims 8 and 14, despite the Examiner's Official Notice that it is well known to have a midsole between an insole and an outsole, the Snabb, et al. patent fails to mention the term midsole let alone whether such an element can be incorporated within the specific structure of its shoe while maintaining its required functional features. Therefore, Applicant respectfully submits that Claims 8, 14, 16, 19, and 20 are patentably distinct from the Snabb, et al. patent.

4. Claims 15 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Snabb, et al. in view of Borgeas. Independent Claim 11, from which Claim 15 depends, has been shown above to be patentably distinct from the Snabb, et al. patent. Moreover, the Borgeas patent does not include any additional disclosure combinable with the Snabb, et al. patent that would be material to patentability of these claims. Therefore, Applicant respectfully submits that Claim 15 is patentably distinct from the proposed Snabb, et al. - Borgeas combination.

CONCLUSION

Applicant has clearly demonstrated that the present invention as claimed is clearly distinguishable over all the art cited of record, either alone or in combination, and satisfies all requirements under 35 U.S.C. §§101, 102, and 103, and 112. Therefore, Applicant respectfully requests the Board of Patent Appeals and Interferences to reverse the final rejection of the Examiner and instruct the Examiner to issue a notice of allowance of all claims.

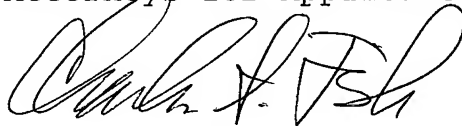
Please charge Deposit Account No. 02-0384 of BAKER BOTTS L.L.P. an amount of \$255.00 to satisfy the appeal brief fee of 37 C.F.R. §41.20(b)(2).

The Commissioner is hereby authorized to charge any fees or credit any overpayments associated with this Application to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.

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August 5, 2008

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APPENDIX A

1. (Previously Presented) A shoe, comprising:

an upper;

an insole enclosed by the upper, the insole being a single piece layer of the shoe, the insole having a forward toe section and a rear heel section;

an outsole supporting the insole, the outsole having a planar support surface directly supporting the forward toe section and the rear heel section of the insole, the outsole having a planar walking surface;

wherein the rear heel section of the insole has a surface closer to the planar walking surface of the outsole than a surface of the forward toe section of the insole to place a wearer's foot in a position where the wearer's heel is closer to a walking surface than the wearer's toes during normal wearing conditions;

wherein the forward toe section of the insole has a substantially constant thickness from a forward periphery edge of the shoe to the rear heel section, the rear heel section of the insole having a decreasing thickness from the forward toe section of the insole to a rear periphery edge of the shoe, wherein the rear heel section of the insole and the forward toe section of the insole meet at a point substantially halfway with respect to the upper surface.

2. (Canceled).

3. (Canceled).

4. (Canceled).

5. (Previously Presented) The shoe of Claim 1, wherein the rear heel section of the insole and the forward toe section of the insole have a same thickness at the point where the rear heel section of the insole and the forward toe section of the insole meet.

6. (Withdrawn and Previously Presented) The shoe of Claim 1, wherein the forward toe section of the insole and the rear heel section of the insole are separated by a cavity.

7. (Withdrawn and Previously Presented) The shoe of Claim 1, wherein the forward toe section of the insole extends short of a forward periphery edge of the shoe.

8. (Previously Presented) The shoe of Claim 1, further comprising:
one or more midsoles between the insole and the outsole.

9. (Withdrawn) The shoe of Claim 8, wherein the midsoles allow the insole to maintain a position of the wearer's heel to be closer to the walking surface than the wearer's toes.

10. (Canceled).

11. (Previously Presented) A shoe, comprising:

an upper;

an insole under the upper, the insole being a single piece layer of the shoe, the insole having a forward toe section and a rear heel section, the insole being configured with a constantly thick forward toe section and a decreasingly thick rear heel section;

an outsole under the insole, the outsole having a planar support surface directly supporting the forward toe section of the insole and the rear heel section of the insole, the outsole having and a planar walking surface;

wherein the rear heel section of the insole has a surface closer to the planar walking surface of the outsole than a surface of the forward toe section of the insole to place a wearer's foot in a dorsiflexion position, wherein the constantly thick forward toe section of the insole and the decreasingly thick rear heel section of the insole meet at a point substantially halfway with respect to the outsole.

12. (Canceled).

13. (Canceled).

14. (Previously Presented) The shoe of Claim 13, further comprising:

one or more midsoles between the insole and the outsole.

15. (Previously Presented) The shoe of Claim 11, wherein the insole is removable.

16. (Previously Presented) A shoe, comprising:

an upper;

an insole enclosed by the upper, the insole being a single piece layer of the shoe, the insole having a forward toe section and a rear heel section;

a midsole separating the outsole from the forward toe section of the insole and the rear heel section of the insole;

an outsole supporting the midsole and the insole, the outsole having a planar support surface supporting the midsole and the insole, the outsole having a planar walking surface, wherein the rear heel section of the insole has a surface closer to the planar walking surface of the outsole than a surface of the forward toe section of the insole to place a wearer's foot in a position where the wearer's heel is closer to a walking surface than the wearer's toes during normal wearing conditions;

wherein the forward toe section of the insole has a substantially constant thickness from a forward periphery edge of the shoe to the rear heel section of the insole, the rear heel section of the insole having a decreasing thickness from the forward toe section of the insole to a rear periphery edge of the shoe, wherein the rear heel section of the insole and the forward toe section of the insole meet at a point substantially halfway with respect to the outsole.

17. (Canceled).

18. (Canceled).

19. (Previously Presented) The shoe of Claim 16, wherein the rear heel section of the insole and the forward toe section of the insole have a same thickness at the point where the rear heel section of the insole and the forward toe section of the insole meet.

20. (Previously Presented) The shoe of Claim 16, wherein the midsole has substantially planar upper and lower surfaces.

EVIDENCE APPENDIX

See attached sheets showing drawing changes made to
FIGURE 14 during prosecution of the Application.

ATTORNEY DOCKET NO.
063293.0110

PATENT APPLICATION
10/790,923

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RELATED PROCEEDINGS APPENDIX

None

ATTORNEY DOCKET NO.
063293.0110

PATENT APPLICATION
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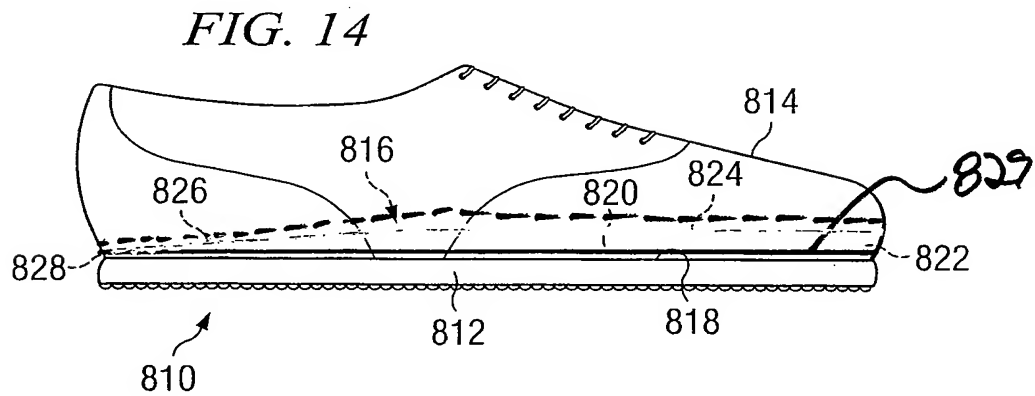
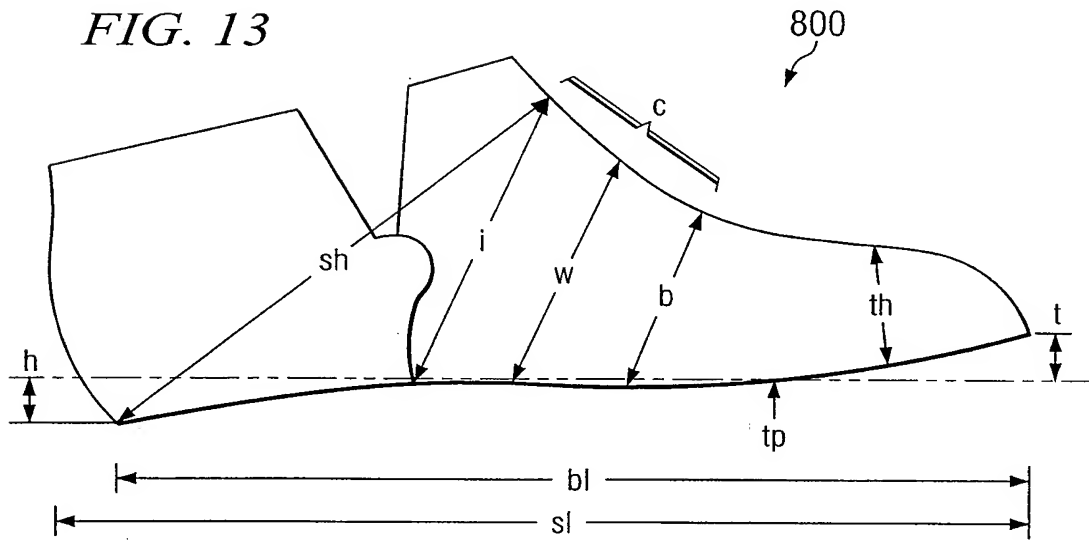
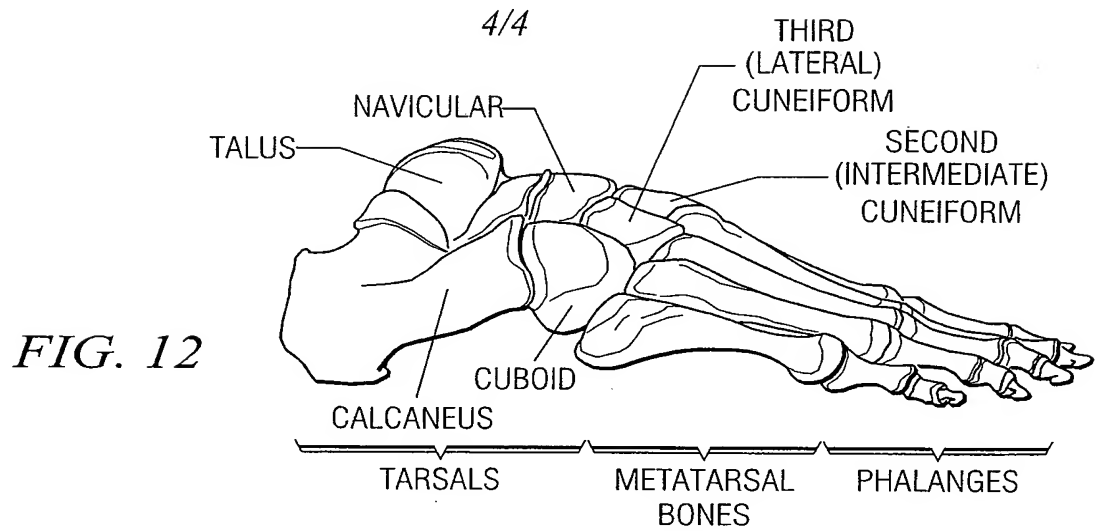
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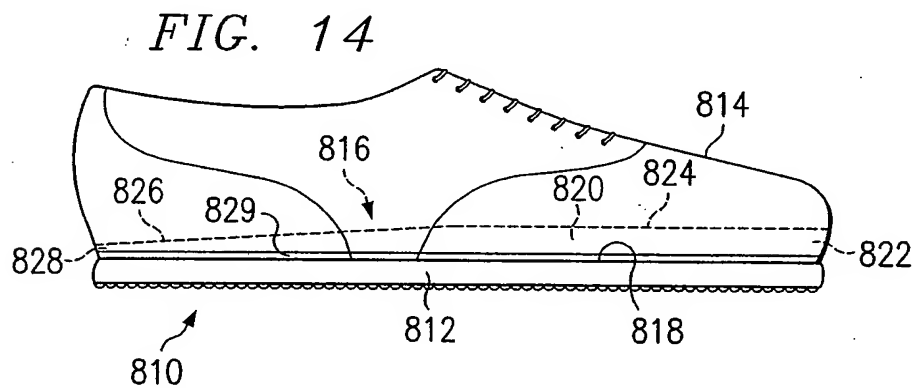
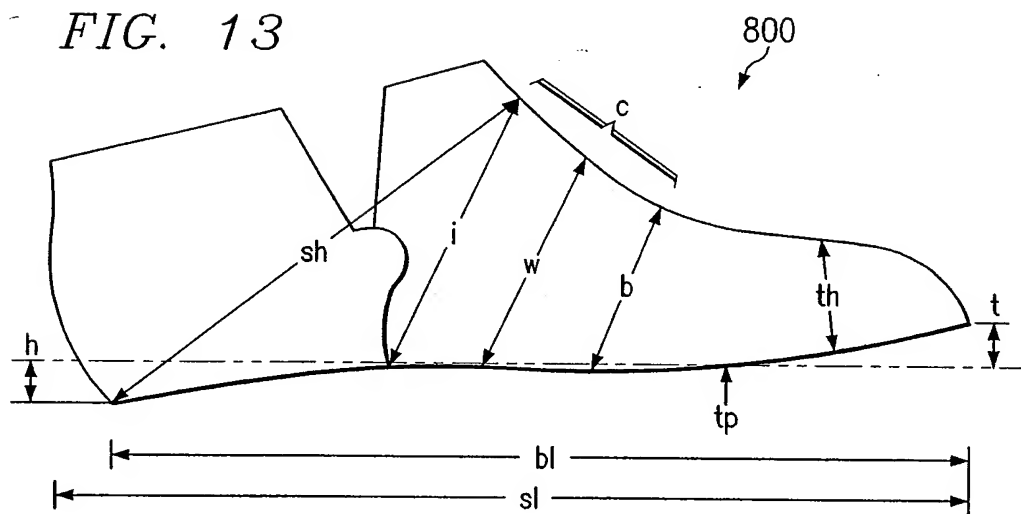
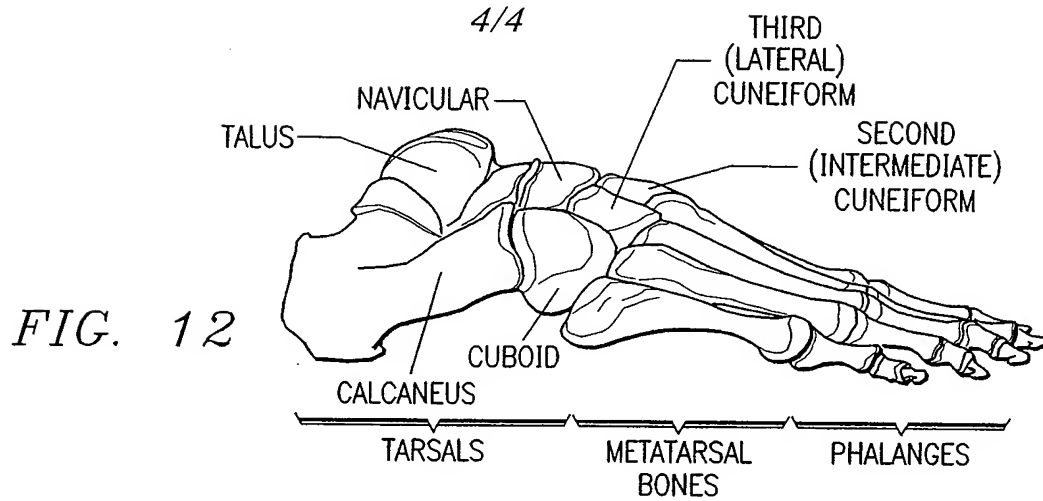
CERTIFICATE OF SERVICE

None

EVIDENCE APPENDIX

See attached sheets showing drawing changes made to FIGURE 14 during prosecution of the Application. The drawing changes show a marked up copy and a clean copy for each change. The change to insert midsole 829 was included in a Response to Examiner' Action file January 7, 2005 in response to an Official Action issued October 7, 2004. The change to accurately show point 824 was included in a Response to Examiner's Final Action filed May 3, 2005 in response to a Final issued March 3, 2005.





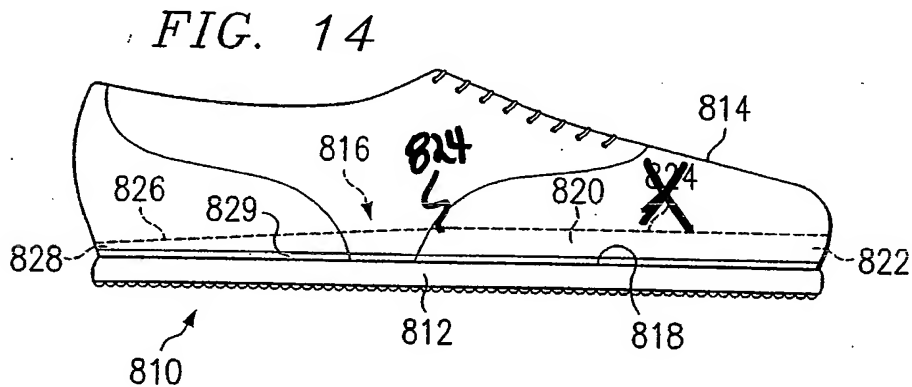
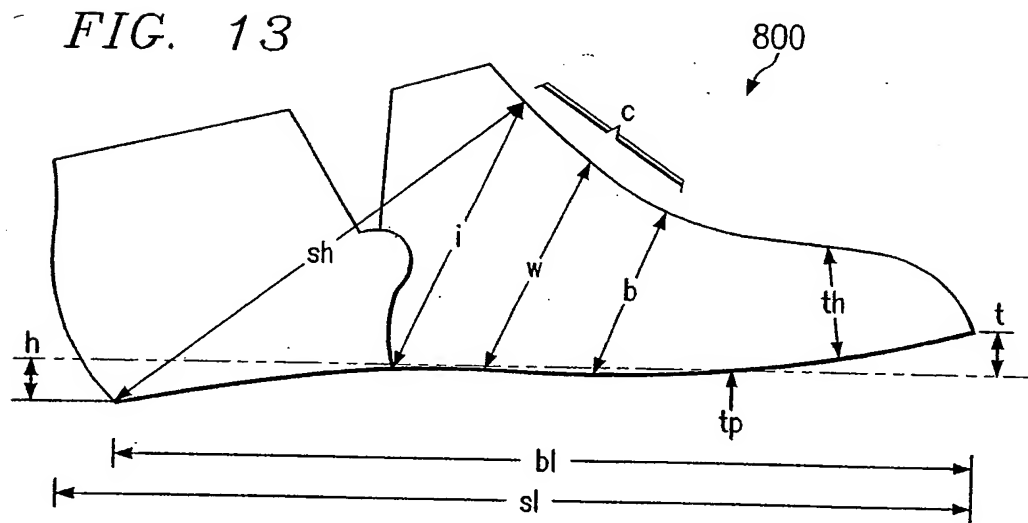
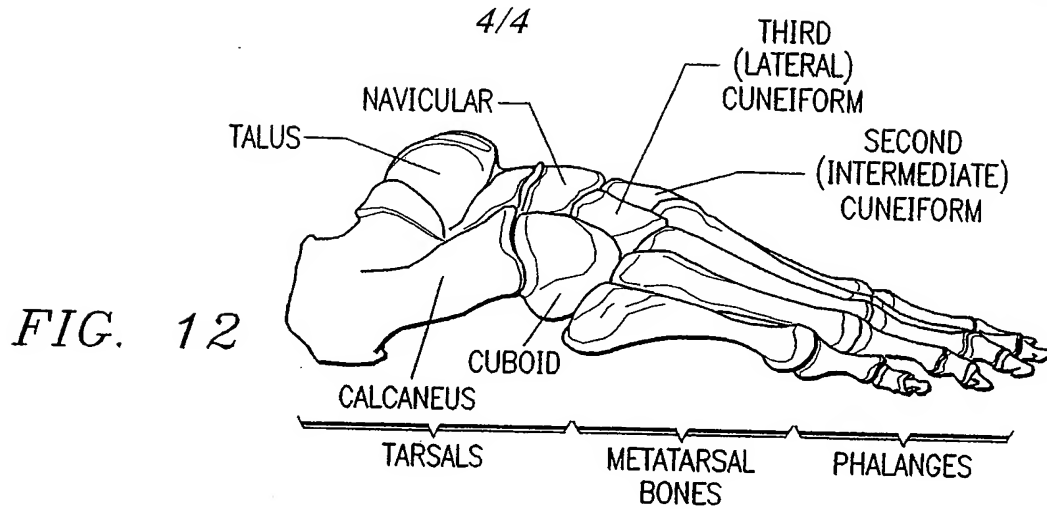


FIG. 12

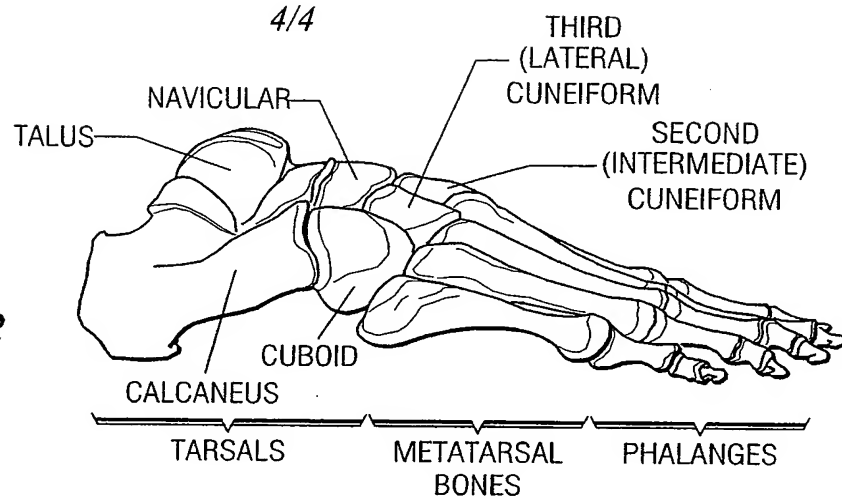


FIG. 13

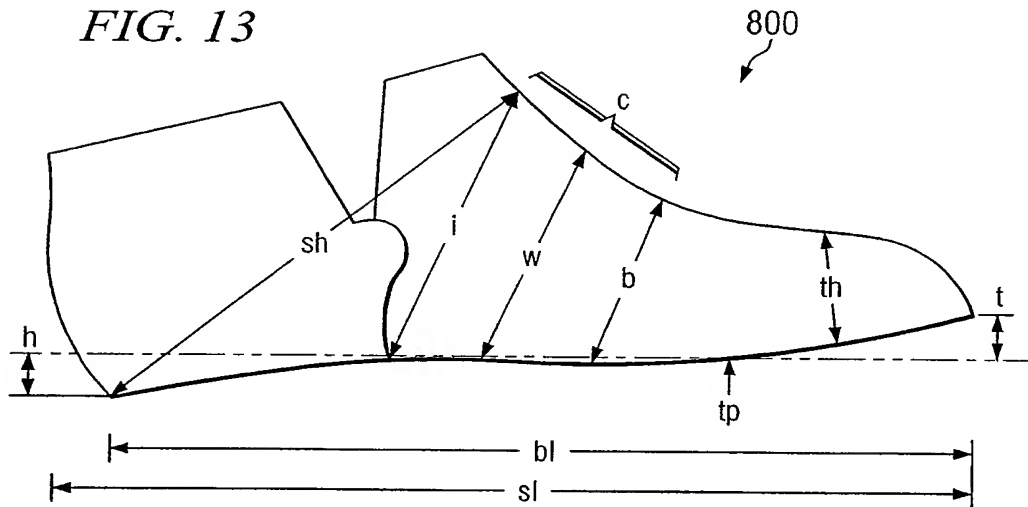


FIG. 14

